



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/047,717 03/25/98 TANIGUCHI

M U-011678-8

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IM62/0718

EXAMINER

SHOSHO, C

ART UNIT

PAPER NUMBER

1714

DATE MAILED:

07/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.

09/047,717

Applicant(s)

Taniguchi et al.

Examiner

Callie Shosho

Group Art Unit

1714



THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☒ expires 6 months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☒ Appellant's Brief is due two months from the date of the Notice of Appeal filed on Jun 30, 2000 (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Jun 30, 2000 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

- ☒ The proposed amendment(s):

☒ will be entered upon filing of a Notice of Appeal and an Appeal Brief.

☐ will not be entered because:

- ☐ they raise new issues that would require further consideration and/or search. (See note below).
- ☐ they raise the issue of new matter. (See note below).
- ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE:

- ☐ Applicant's response has overcome the following rejection(s):

- ☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

- ☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:

see attachment

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: _____

Claims objected to: _____

Claims rejected: 1-11 and 13-22

- ☐ The proposed drawing correction filed on _____ ☐ has ☐ has not been approved by the Examiner.

- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

- ☐ Other

Art Unit: 1714

Attachment to Advisory Action

1. Applicants' amendment filed 6/30/00 (Paper No. 11) has been considered. However, the arguments are not persuasive for the following reasons.

Tomita et al. (U.S. 5,019,164) discloses a mixture of cationic resins, namely, a mixture of a polyamine containing primary amino groups with a polyamine containing secondary or tertiary amino groups wherein Tomita et al.'s resins, specifically those found in formulas (v) and (vi), are identical to the cationic resin presently claimed when n is 0 or 1.

Applicants argue that the insertion of "consisting essentially of" in line 4 of claim 1, excludes from the claimed ink composition the presence of cationic, water-soluble resins other than that of recited formula 1 and thus, Tomita et al., which discloses a mixture of cationic resins, is no longer a relevant reference against the present claims.

This argument is not persuasive, however, given that the claim language found in line 1 of present claim 1, i.e. "ink composition *comprising*", clearly allows for the inclusion of an additional resin in the presently claimed ink composition including a cationic resin such as a polyamine containing primary amino groups as found in Tomita et al.

If applicant were willing to include the limitation of present claim 11 into present claims 1 and 22 along with the limitation that the resin other than the cationic, water-soluble resin is nonionic, the examiner would be willing to reconsider the rejection.

Applicants further argue that the preferred resins of Tomita et al. are polyethyleneimines which are outside the scope of the present invention. However, "applicant must look to the whole

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reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others.” In re Courtright, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). Further, “nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims.” In re Nehrenberg, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). Although Tomita et al. uses polyethyleneimine in the examples, two of the three cationic resins containing secondary or tertiary amino groups disclosed by Tomita et al. are of the type utilized in the present invention, and thus it would have been within the skill level of one of ordinary skill in the art to choose the cationic resin presently claimed without undue experimentation.

In light of the above, Tomita et al. remains as a very relevant reference against the present claims.

C.S.

Callie Shosho

7/14/00

Vasu Jagannathan
Vasu Jagannathan
Supervisory Patent Examiner
Technology Center 1700

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